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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,709	07/31/2003	Takashi Yokohari	520.42960X00	1601
24956 7590 02/23/2007 MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C. 1800 DIAGONAL ROAD SUITE 370 ALEXANDRIA, VA 22314			EXAMINER CHANNAVAJJALA, SRIRAMA T	
			ART UNIT 2166	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	
3 MONTHS			02/23/2007	
			DELIVERY MODE PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/630,709

Applicant(s)

YOKOHARI ET AL.

Examiner

Srirama Channavajjala

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2166

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 10/630,709.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to RCE

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed [01/22/2007] in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. and a non-final Office action is as follows:
2. claims 1-9 have been cancelled [1/22/2007].
3. Claims 10-12 have been added [1/22/2007].
4. Claims 1,3,5,6-9 are presented for examination.
5. Examiner acknowledges applicant's amendment filed on 7/6/2006.
6. Claims 1,3,5,6-9 have been amended [7/6/2006].
7. Claims 2,4 have been cancelled [7/6/2006].

Drawings

8. Examiner approved "proposed drawings fig 1-3,8", filed on 7/6/2006, a copy of the drawings fig 1-3,8 enclosed with the previous office action, and replacement drawing sheets including the correction is required in response to this office action.
9. The Drawings filed on 7/31/2003 are acceptable for examination purpose

Priority

10. Acknowledgment is made of applicant's claim for foreign priority based on JP 2003-005208 filed on **14 Jan 2003** under 35 U.S.C. 119(a)-(d), the certified copy has been filed in the Application No. 10/630,709, filed on 7/31/2003.

Information Disclosure Statement

11. The information disclosure statement filed on 1/22/2007 is in compliance with the provisions of 37 CFR 1.97, and has been considered [only Abstract in English] and a copy is enclosed with this Office Action.

12. The information disclosure statement filed on 7/31/2003 is in compliance with the provisions of 37 CFR 1.97, and has been considered [Abstract in English only] and a copy was mailed with previous Office Action.

Claim Rejections - 35 USC § 112

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 10-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

15. The metes and bound of the system steps of claim 10 are unclear. In claim 10, merely providing a database such that the system do not actually integrate the database, but creates reference material. The steps of "a produced document...", "a name of reference material....", "a first relating degree....", "a second relating degree....", "a total time during.....", "a frequency of referencing.... Wherein within a job....."are indefinite as they lack concrete active limitations as to how the steps are to be accomplished. One of skill in the art would not be able to determine what exactly must be done to accomplish the goal of the preamble. It is unclear how the first relating degree, a second relating degree with respect to total time related to reference material and referencing frequency.

16. The limitation of claim 11 does not appear to be a further system step and does not appear to further limit the system of claim 1. It is unclear which "**name of a tool, such as, a software program, etc**" being used. It appears that claim "**a software**

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program, etc.” itself indefinite and steps of the claim do not meet the goal of the preamble of the independent claim.

17. In the claim 12, how are the “parental relationship between a plural number of the produced document” is identified? How does one “identify relationship”? according to the system? The limitation lacks positive active steps to be taken in the execution of system.

18. Claims 11-12 are indefinite because claims 11-12 depend from **“cancelled claim 1”**, for compact prosecution, examiner assumes and treated that claim 11-12 depend from claim 10 in the office action.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

19. ***Claims 1-46 are rejected under 35 U.S.C. 101 because invention is directed to non-statutory subject matter.***

As set forth in MPEP 2106(II)A:

*Identify and understand Any Practical Application Asserted for the Invention. The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d at 1373, 47USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); In re Ziegler, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)). Accordingly, a complete disclosure should contain some indication of the **practical application** for the claimed invention, i.e., why the applicant believes the claimed invention is useful.*

*Apart from the utility requirement of 35 U.S.C. 101, usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See Arrhythmia, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material **stored in a***

computer-readable medium does not make the invention eligible for patenting.

*For example, a claim directed to a word processing file stored on a disk may satisfy the utility requirement of 35 U.S.C. 101 since the information stored may have some “real world” value. However, the mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 **does not mean that a useful result is achieved under the practical application requirement. The claimed invention as a whole must produce a “useful, concrete and tangible” result to have a practical application.***

20. Claims 10-12 are rejected under 35 USC 101 because the claimed invention is directed to non-statutory subject matter. The claims are drawn to system of manipulating “data in database” therefore. The steps of the system do not produce a “result” that is concrete tangible and useful. At best, the steps of claim 10 appear to provide a “reference history database” without having any relation whatsoever with “name of reference material”, “first relating degree”, “second relating degree” and “total time”, “frequency of referencing...” and like, particularly, “first relating degree, second relating degree” with respect to “total time” has no intrinsic meaning, value, or usefulness. The results must be further manipulated or interpreted by the user to be useful. These steps are not statutory. See MPEP 2106. “For such subject matter to be statutory, the claimed process must be limited to a practical application of the abstract idea or mathematical algorithm in the technological arts. See *Alappat*, 33 F.3d at 1543, 31 USPQ2d at 1556-57 (quoting *Diamond v. Diehr*, 450 US. At 192, 209 USPQ at 10). See also *Alappat* 33 F.3d at 1569, 31 USPQ2d at 1578-79 (Newman, J., concurring)

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("unpatentability of the principle does not defeat patentability of its practical applications") (citing O "Reilly v. Morse, 56 US. (15 How.) at 114-19). A claim is limited to a practical application when the method, system as claimed, produces a concrete, tangible and useful result; i.e., the method or system recites a step or act of producing something that is concrete, tangible and useful. See AT &T, 172 F.3d at 1358, 50 USPQ2d at 1452.

The examiner reviewed the specification at page page 6, line 31-33, page 11, line 15-33, page 12-13, page 16-17, but was unable to find a practical real-world use of the result

If the applicant is able to find one and inserts it into the claims provide the location the element is found in the specification.

The claims 11-12 dependent from claim 10 is also rejected in the above analysis.

Claim Rejections - 35 USC § 102

21. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

22. Claims 10-12 are rejected under 35 U.S.C. 102(e) as being anticipated by

Nakao, US Patent No. 6963830 filed on June 14, 2000.

23. As to claim 10, Nakao teaches a system which including 'a job guidance and assistance system or guiding and assisting a job of producing a document' [col 4, line 16-23], Nakao teaches detection, extraction of topic from documents and generating summaries corresponds to assisting a job of producing a document;

'a reference history database' [fig 2, element 11];

'a computer, wherein the computer is programmed to store in the reference history database' [fig 2, element 12];

'a produced document, which is produced in the past' [col 8, line 66-67, fig 2];

'a name of reference material, which is referred to for producing said produced document' [col 8, line 10-15, fig 2], Nakao specifically teaches topic structure detects topic passages from the document which is a continuous document parts corresponds to reference material;

'a first relating degree, [col 8, line 32-42], relating degree corresponds to Nakao's topic boundary relation degree;

which is determined based upon frequency of appearance of a rare word that appears within said produced document and said reference material' [col 10, line 12-15, line 46-51, col 14, line 36-44, fig 17], Nakao specifically teaches not only calculating relating degree of document words, but also number of times of use of document with respect to relating degree of document words as detailed in col 14, line 36-44, fig 17;

'a second relating degree [col 12, line 30-47], Nakao also teaches calculation of cohesion degree both forward and backward with respect to document as detailed in col 12, line 30-47;

which is determined by a number of appearances of a document category within said produced document and said reference material' [col 12, line 41-55]; Nakao specifically teaches appearance frequency of words that are part of document category as detailed in col 12, line 41-47;

a total time during which said reference material is opened when producing the produced document' [col 14, line 47-53, fig 17], Nakao specifically teaches total number of times use of document with respect to referenced four-term, three-term and two-term average as detailed in fig 17;

'a frequency of referencing said reference material for completing said produced document, by relating said reference material and said produced document to one another' [col 16, line 10-19];

'wherein within a job for producing a new document, there is displayed, as an item of priority, said first relating degree, said second relating degree, said total time [col 15, line 34-40]; and said referencing frequency, and there is displayed said reference material resulting from a search by referring to said first relating degree, said second relating degree, said total time, and said referencing frequency, respectively' [col 15, line 41-46, fig 19].

24. As to claim 11, Nakao disclosed 'URL of a web page, which is referred to when producing said produced document, and a name of a tool, such as, a software program, etc.. which is used when producing said produced document, are stored in said reference history database, with reference to said produced document' [col 26, line 33-36, line 57-65].

25. As to claim 12, Nakao disclosed 'information indicative of a parental relationship between a plural number of the produced document is stored in said reference history database, to be displayed on the job for producing a new document' [col 5, line 66-67, col 6, line 1-6].

Response to Arguments

26. Applicant's arguments filed on 1/22/2007 with respect to claims 1,3,5-9 [cancelled] have been considered but are moot in view of the new ground(s) of rejection. [new claims 10-12]

Conclusion

The prior art made of record

US Pub. No. 6963830

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Srirama Channavajjala whose telephone number is 571-272-4108. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alam, Hosain, T, can be reached on (571) 272-3978. The fax phone numbers for the organization where the application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free)

SC
Patent Examiner.
February 12, 2007


SRIRAMA CHANNAVAJJALA
PRIMARY EXAMINER